



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/720,537 | 06/27/2001 | Tatsuo Eguchi | 209880US6PCT | 3348 |

22850 7590 05/14/2009
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA, VA 22314

| |
|----------|
| EXAMINER |
|----------|

VAN HANDEL, MICHAEL P

| | |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
|----------|--------------|

2424

| | |
|-------------------|---------------|
| NOTIFICATION DATE | DELIVERY MODE |
|-------------------|---------------|

05/14/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com
oblonpat@oblon.com
jgardner@oblon.com

| | | | |
|------------------------------|---------------------------------------|--------------------------------------|--|
| Office Action Summary | Application No. 09/720,537 | Applicant(s) EGUCHI ET AL. | |
| | Examiner MICHAEL VAN HANDEL | Art Unit 2424 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 March 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 15-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 15-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. This action is responsive to an Amendment filed 3/02/2009. Claims **15-30** are pending. Claims **15, 19, 23**, and **27-30** are amended. Claims **1-14** are canceled. The examiner hereby withdraws the objection to claim **30** in light of the amendment.

Response to Arguments

1. Applicant's arguments regarding claims **15, 19, 23**, and **27**, filed 3/02/2009, have been fully considered, but they are not persuasive.

Regarding the rejection of claim **27** under 35 USC 101, the applicant argues that the amendment clarifies the claim subject matter and addresses the rejection under 35 USC 101. The examiner respectfully disagrees. The examiner notes that the word "tangible" means "real or actual, rather than imaginary or visionary" (see definition of "tangible" at <http://dictionary.reference.com/browse/tangible>). As noted in the Office Action below, Applicant's specification states that the medium can be the transmission medium for a program over a radio path from a downloading site through an artificial satellite for digital satellite broadcasting to the personal computer, or transmitted through a network, a local area network or Internet, so as to be stored in the enclosed hard disc in the personal computer (p. 56, paragraph 4 of Applicant's specification). The examiner notes that this description of medium can be interpreted to be tangible, as currently amended, and that Applicant's specification fails to distinguish tangible media from intangible media. The examiner further notes that a claim

Art Unit: 2424

directed to a signal *per se* does not appear to be a process, machine, manufacture, or composition of matter. See **MPEP 2106.01** for guidance.

Regarding claims **15**, **19**, **23**, and **27**, the applicant argues that Daniels does not disclose or suggest storing a program table simultaneously displaying a plurality of programs with additional respective request buttons for record reservation data, such that each displayed program has its own corresponding unique request button for record reservation data simultaneously displayed with the respective displayed program, selection of a respective of the request button for record reservation data directly generating recording reservation data for the corresponding displayed program. Applicant specifically argues that Daniels does not disclose or suggest that any program table simultaneously displays a plurality of programs each with its own respective unique request button for record reservation data. The examiner respectfully disagrees. As noted in the Office Action mailed 12/01/2008, Daniels discloses a system in which a user is provided access to a computer network source of program information and data instructions via an Internet modem connection. Daniels further discloses multiple Web page arrangements for displaying the program information for user selection. Figure 23 shows the Web page that is displayed when a user navigates through the “day” option of column A. Column B pops up with a list of the days of the week. Columns C, D, and E pop up and the user makes the desired selections. Column F pops up with the program schedule information. Once the user selects a program, column G pops up with the option of recording the program with a VCR (p. 15, paragraph 150 & Fig. 23). As previously noted by the examiner, a user must select a program button from Column F before they can select to record the program (p. 15, paragraph 150 & Fig. 23). Therefore, the program buttons 1-22 in Column F can be interpreted to be

Art Unit: 2424

corresponding unique buttons for record reservation data, as currently claimed. The examiner acknowledges Applicant's argument that no reasonable interpretation of Daniels would correspond to the claims as currently written; however, the examiner respectfully disagrees. In order to record Guligan's Island the user must select button (21) Guligan's Island to select the record button.

Further regarding claims **15, 19, 23, and 27**, the applicant argues that the claims clearly recite the simultaneous display of two different pieces of information for each program, specifically a plurality of programs and additional request buttons for record reservation data, and such that each displayed program has its own corresponding button. Applicant further argues that a single display of a program name as in points (1)-(22) in columns A and B in Figure 23 of Daniels could not correspond to such different displays. The examiner respectfully disagrees. Daniels discloses displaying a plurality of programs as text within cells (1)-(22). Daniels also discloses that each of the cells acts as a button that the user selects in order to record the program (Fig. 23). As such, the examiner maintains that Daniels meets teaches the simultaneous display of programs and additional request buttons for record reservation data, such that each displayed program has its own corresponding unique button, as currently claimed.

Still further regarding claims **15, 19, 23, and 27**, the applicant argues that selecting the different programs in Daniels would not meet the limitation of "directly generates a recording reservation data for a corresponding displayed program." The examiner respectfully disagrees. Daniels discloses that, upon selection of a program cell, an option to record the program is displayed to the user in Column G (Fig. 23). As such, the examiner maintains that Daniels meets the limitation of "selection of a respective of the request button for record reservation data

Art Unit: 2424

directly generating recording reservation data for the corresponding displayed program,” as currently claimed. Daniels further discloses that the user can select option (2) to record the program (p. 15, paragraph 150 & Fig. 23). Since selection of both the program cell and record cell sets the program for recording on the VCR, the examiner interprets selection of the program cell as “directly generating recording reservation data,” as currently claimed. The examiner further notes that Applicant’s specification does not appear to disclose that there are no intervening steps between the selection of a record button and the downloading of reservation data.

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims **27-30** are rejected under 35 U.S.C. 101, because the claimed invention is directed to non-statutory subject matter.

Referring to claims **27-30**, the claims are directed towards a tangible computer readable medium; however, the examiner notes that the specification defines that the medium can be the transmission medium for a program over a radio path from a downloading site through an artificial satellite for digital satellite broadcasting to the personal computer, or transmitted through a network, a local area network or Internet, so as to be stored in the enclosed hard disc in the personal computer (p. 56, paragraph 4 of Applicant’s specification). The examiner notes that a claim directed to a signal *per se* does not appear to be a process, machine, manufacture, or composition of matter. See **MPEP 2106.01** for guidance.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims **15, 16, 19, 20, 23, 24, 27, 28** are rejected under 35 U.S.C. 102(e) as being anticipated by Daniels.

Referring to claims **15, 16, 19, 20, 23, 24, 27, and 28**, Daniels discloses an information processing apparatus/method, comprising a server configured to store a program table simultaneously displaying a plurality of programs with additional request buttons for record reservation data, such that each displayed program has its own corresponding unique request button for record reservation data simultaneously displayed with the respective displayed program, selection of a respective of the request button for record reservation data directly generating recording reservation data for the corresponding displayed program (p. 14, paragraphs 144, 145; p. 15, paragraphs 146, 150-152; & Figs. 19, 23-25); the server further configured to allow a user to select programs on the program table by selecting one of the respective request buttons for record reservation data on the program table corresponding to a respective program, the user accessing the server from a remote device through a network; and the server further configured to transmit the generated record reservation data to the remote device of the user upon the user selecting at least one of the additional request buttons for record reservation data in

Art Unit: 2424

the program table, and based on the user selections of the at least one of the additional request buttons for record reservation data in the program table, the transmitted record reservation data for controlling the recording of a picture at the user remote device, and including data for specifying a channel, data indicating the date and time for starting the recording, and data (duration data) indicating the date and time for terminating the recording to a picture recording apparatus (p. 3, paragraphs 24, 25; p. 13, paragraphs 130, 131, 133-136; p. 14, paragraphs 140-146; p. 15, paragraphs 146, 150, 151; p. 17, paragraphs 165-168; & Figs. 7-11, 15-19, 23-26, 36, 37-41).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims **17, 18, 21, 22, 25, 26, 29, 30** are rejected under 35 U.S.C. 103(a) as being unpatentable over Daniels in view of vCalendar Specification, v0.4.

Referring to claims **17, 21, 25, and 29**, Daniels discloses the information processing apparatus/method according to claims 15, 19, 23, and 27, respectively. Daniels also discloses that a calendar scheduling application is operated depending on VCR control information (p. 13, paragraph 136). Daniels further discloses that VCR control information can be updated via email (p. 14, paragraph 140). Daniels does not disclose that the transmitted data is data of a v-calendar system. vCalendar specification, v0.4 discloses the use of the vCalendar format in

Art Unit: 2424

point-to-point communication (p. 1, paragraph 4), where vCalendar data streams are created with a vCalendar Writer and are read with a vCalendar reader (p. 1, paragraph 6). It would have been obvious to one of ordinary skill in the art at the time that the invention was made to modify Daniels to include the use of a vCalendar format, such as that taught by vCalendar Specification, v0.4 in order to collect and communicate PDI information across e-mail (p. 1, paragraph 2).

Referring to claims **18, 22, 26, and 30**, the combination of Daniels and vCalendar specification, v0.4 teach the information processing apparatus according to claims 15, 19, 23, and 27, respectively, wherein the transmitted data comprises text data including the information specifying the date and time of starting the recording, the recording start date and time specifying information being stated next to the information indicating the start of the recording reservation data “BEGIN:VCALENDAR” (vCalendar Specification v0.4 p. 5, 2.2.1), “DTSTART:” (vCalendar Specification v0.4 p. 6, 2.1.2), the information specifying the date and time of end of recording, the recording end date and time specifying information being stated next to “DTEND:” (vCalendar Specification v0.4 p. 23, paragraph 2.3.11), the information specifying a channel for recording, the channel specifying information being stated next to “LOCATION:” (vCalendar Specification v0.4 p. 24, 2.3.15), the name of a program for recording, recorded next to “DESCRIPTION:” (vCalendar Specification v0.4 p. 6, 2.1.3) , and the information “END:VCALENDAR” (vCalendar Specification v0.4 p. 5, 2.2.1) indicating the end of the recording reservation data.

Conclusion

Art Unit: 2424

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL VAN HANDEL whose telephone number is (571)272-5968. The examiner can normally be reached on 8:00am-5:30pm Mon.-Fri..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Kelley can be reached on 571-272-7331. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2424

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Christopher Kelley/
Supervisory Patent Examiner, Art Unit
2424

MVH